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Lisa A. Haile, Ph.D.  
Gray Cary Ware & Freidenrich LLP  
4365 Executive Drive  
Suite 1100  
San Diego, CA 92121-2133

EXAMINER

KIELIN, ERIK J

ART UNIT

PAPER NUMBER

2813

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/905,157

### Applicant(s)

LEWIS ET AL.

### Examiner

Erik Kielin

Art Unit

2813

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on 31 March 2004.
- 2a)  This action is FINAL. 2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 1,4-8,11-13,16-27 and 30-41 is/are pending in the application.
- 4a) Of the above claim(s) 6-8,18-20 and 31-40 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1,4,5,11-13,16,17,21-27,30 and 41 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a)  All b)  Some \* c)  None of:
    1.  Certified copies of the priority documents have been received.
    2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4)  Interview Summary (PTO-413)

Paper No(s)/Mail Date \_\_\_\_\_

- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

This action responds to the Amendment filed 31 March 2004.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 11, 12, and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claims 1 and 13 require the silicon-containing material to be monocrystalline. Dependent claims 11 and 30 require the same silicon-containing material to be amorphous. This is impossible because monocrystalline silicon cannot simultaneously be amorphous, thereby rendering claims 11 and 30 not enabled. Similarly, dependent claim 12 requires the silicon to have porosity up to 30 percent. Porous silicon is, at best, polycrystalline, but is more likely completely amorphous --not crystalline. Monocrystalline silicon cannot be simultaneously porous. Accordingly, claim 12 is not enabled.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 5, 11, 41 and 13, 16, 17, 21, 25-27, 30 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,429,708 (Linford et al.).

Regarding claims 1, 11 and 13, 30, Linford discloses a semiconductor substrate comprising,

providing an, *inter alia*, monocrystalline or amorphous (instant claims 11 and 30) or porous silicon-containing material 12 (col. 1, lines 17-21) having a surface 40 substantially free of oxidation (as shown in Figs. 2A, 2B, 3, etcetera; and as stated at col. 2, lines 6-45); and

forming an organic monolayer 44, 45, 46 having more than half of its atoms being carbon and hydrogen (because R is, *inter alia*, alkyl, alkenyl, aryl, cycloalkyl...” [col. 5, lines 5-13] which are 100% carbon and hydrogen) wherein the organic layer is chemically bonded to the surface 10, 30, 32, 38 of the silicon-containing material 12 (col. 2, lines 6-45) and wherein an electrical property of the electrical structure is altered and/or improved compared to a same substrate without the organic layer, as indicated by Linford (col. 1, 21-31; paragraph bridging cols. 8-9; all figures):

For example, Linford states in the paragraph bridging cols. 8-9,

“For example, such molecular layers are suitable for use with: silicon based, micromechanical devices to minimize stiction; **electrode surfaces to optimize their electrochemical properties for use in fuel cells or electrochemical synthetic cells; solar cells as an antioxidant coating**, silicon chips as a monomolecular photoresist, and Si-based chemical sensors to **alter the electrical properties of the underlying Si.**” (Emphasis added.)

The word "optimization," by definition, is to improve, and the word "alter" is a synonym of the word "change." Accordingly, **Linford** expressly and inherently teaches both changing and improving of the electrical properties of the semiconductor substrate.

It is seen to be inherent that the organic layer changes the electrical property of the silicon-containing material, wherein the electrical properties is selected from a group consisting of surface recombination velocity, carrier lifetime, electronic efficiency, voltage, contact resistance, and resistance of a doped region. Evidence is the admission of Applicant in the instant specification (for example at p. 7, paragraph [0031] and paragraph bridging pp. 15-16, [0056]).

See *In re Swinhart*, 169 USPQ 226,229 (CCPA 1971) (where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that subject matter shown to be in the prior art does not possess the characteristics relied on) and *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980) (the burden of proof can be shifted to the applicant to show that subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 USC 102 or obviousness under 35 USC 103).

Note that as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Two prior art references disclosed blasting compositions containing water-in-oil emulsions with identical ingredients to those claimed, in overlapping ranges with the claimed composition. The only element of the

claims arguably not present in the prior art compositions was "sufficient aeration . . . entrapped to enhance sensitivity to a substantial degree." The Federal Circuit found that the emulsions described in both references would inevitably and inherently have "sufficient aeration" to sensitize the compound in the claimed ranges based on the evidence of record (including test data and expert testimony). This finding of inherency was not defeated by the fact that one of the references taught away from air entrapment or purposeful aeration.). See also *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 139 (Fed. Cir. 1986); *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 782, 227 USPQ 773, 778 (Fed. Cir. 1985).

In the decision in *Toro Co. v. Deere & Co.*, 69 USPQ2d 1584 (CA FC 2004), at page 1590, last paragraph, it was held that if "one or more embodiments -- whatever the settings of their operational features -- [] necessarily include or result in the subject matter of [the] limitation," then inherent anticipation of the limitation exists.

Regarding claim 4, the organic layer is a hydrocarbon (Fig. 4; col. 4, line 44 to col. 5, line 13).

Regarding claims 5 and 17, the organic layer is a polymer **46** (Fig. 12; col. 5, lines 37-45).

Regarding claim 16, the organic layer is a monolayer (Figs. 3-12).

Regarding claims 21, the organic layer is formed by activating the surface of the silicon-containing material; and reacting the activated surface with a chemical, wherein during the reaction, a hydrocarbon group becomes chemically bonded to the silicon-containing material. (See col. 2, lines 6-45.)

Regarding claim 25, the hydrocarbon is an allyl, called "alkenyl" and structurally described as "-C(R)=CH(R')" for example, in **Linford** (col. 5, lines 5-34).

Regarding claim 26, a polymer is formed by reaction with the surface-bound allyl group (col. 5, lines 37-46; paragraph bridging cols. 5 and 6).

Regarding claim 27, the hydrocarbon group is an alkoxide group (col. 4, lines 44-49; Fig. 5).

Regarding claim 41, **Linford** uses a hydrogen-terminated silicon surface prior to forming the organic layer (Abstract).

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Linford** in view of US 3,961,353 (**Aboaf** et al.).

The prior art of **Linford**, as explained above, discloses each of the claimed features except for indicating the porosity to have an upper limit of 30%.

**Aboaf** teaches a semiconductor device having a porous layer of silicon 12, wherein the silicon has a porosity of 15%. The silicon layer has a protective layer 15 formed there over to prevent oxidation in subsequent processes. (See col. 2, lines 41-61; col. 3, lines 3-13.)

It would have been obvious for one of ordinary skill in the art, at the time of the invention to limit the porosity to no greater than 15% in order to form the device in **Aboaf**. Furthermore, the degree of porosity at no greater than 30% is an obvious matter of design choice and of routine optimization, depending upon the particular application of the porous silicon, at the suggestion of **Linford** to use porous silicon --especially since Applicant has provided no reason why the percentage porosity of the silicon bears any criticality to the formation of the organic layer.

7. Claims 13, 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-84853 A (**Tsukune** et al.) in view of **Wolf**, et al. Silicon Processing for the VLSI Era, Vol. 1-Process Technology, Lattice Press: Sunset Beach CA, 1986, p. 5.

Regarding claims 13 and 21-24, **Tsukune** discloses activating a silicon-containing material (silicon, Si) by halogenating with HF (F is the halogen) and then reacting the activated silicon-containing material surface with a chemical (methanol) to chemically bond a monolayer of methyl groups to the silicon in the surface which has only 1 carbon atom. (See paragraphs [0010]-[0012], translation provided.) **Tsukune** teaches that the electrical property of, at least, voltage in the silicon is improved (a "change") because defects are prevented in the contact between the tungsten or silicon deposited on the silicon-containing material (wafer) (paragraph [0018]). Accordingly, the contact resistance is improved.

In addition to improvement of the contact resistance, it is seen to be inherent that the organic layer also changes an electrical property of the silicon-containing material selected from a group consisting of surface recombination velocity, carrier lifetime, electronic efficiency,

voltage, contact resistance, and resistance of a doped region. Evidence is the admission of Applicant in the instant specification (for example at p. 7, paragraph [0031] and paragraph bridging pp. 15-16, [0056]).

**Tsukune** does not indicate that the silicon semiconductor wafer is monocrystalline. If it is thought that the silicon wafer of **Tsukune** is not monocrystalline, then this may be a difference. However, **Wolf** teaches that it is notoriously well known to fabricate silicon semiconductor devices on single crystal silicon because polycrystalline silicon "would exhibit inadequately short minority carrier lifetimes, due to defects occurring at the grain boundaries of the polycrystalline grains." Accordingly, it would have been obvious for one of ordinary skill in the art, at the time of the invention to use monocrystalline silicon wafers in **Tsukune** to ensure sufficiently high minority carrier lifetimes to enable workable semiconductor devices, as taught in **Wolf**.

#### *Response to Arguments*

8. Applicant's arguments filed 31 March 2004 have been fully considered but they are not persuasive.

Applicant argues that Linford does not teach each of the features of the claims as presently amended. Examiner respectfully disagrees for reasons indicated in the rejection of the claims above. All claimed elements are disclosed expressly or inherently. Applicant fails to provide evidence refuting the inherency. Note especially as stated above that only one embodiment in the applied reference must meet the limitation to meet the requirement of inherent anticipation.

Tsukune too teaches each of the features except for expressly stating that the silicon substrate is monocrystalline. However, it is notoriously well known to use monocrystalline silicon to fabricate semiconductor devices.

Applicant's arguments regarding Linford in view of Aboaf are noted, but as noted above, Claim 12 is not enabled since silicon which is porous is cannot simultaneously be monocrystalline. Accordingly, these arguments are moot. Moreover, there exists nothing critical to the claimed upper limit to porosity in the disclosure.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erik Kielin whose telephone number is 571-272-1693. The examiner can normally be reached on 9:00 - 19:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead, Jr. can be reached on 571-272-1702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Erik Kielin  
Primary Examiner  
18 May 2004